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IN THE

Supreme Court of the United States

OCTOBER TERM 1949

FRANCIS H. MONTMARQUET, d.b.a.
The O. C. Manufacturing Company,
Petitioner,

v.

JOHNSON & JOHNSON,
Respondent.

No. 765

BRIEF FOR RESPONDENT IN OPPOSITION

Opinions Below

The opinion of the United States District Court for the District of New Jersey is reported at 82 F. Supp. 469.

The opinion of the Court of Appeals for the Third Circuit is reported at 179 F. 2d 240.

Jurisdiction

Petitioner invokes the jurisdiction of this court under the Judicial Code, Title 28 § 1254(1).

The judgment of the United States Circuit Court of Appeals for the Third Circuit, which petitioner seeks to have reviewed, was entered on January 23, 1950.

Question Presented

Did the lower courts resolve a *genuine* issue of fact in granting defendant's motion for summary judgment, holding the patent in suit invalid?

Statement

The patent in suit relates to athletic supporters (jock straps). These articles have a belt, or waistband, which may extend either substantially horizontally around the body of the wearer, just as a trousers belt does, or it may have a "drop front" several inches lower than the back.

The patent in suit relates to supporters with "drop fronts". The supposed invention is said to be in the particular way the belt is folded, or overlapped, to make the "drop front".

The prior Johnson patent 1,155,659 (R. 60a) shows a catamenial belt with a drop front, provided by a fold in exactly the same manner as in the patent in suit. Also, as in the patent in suit, the horizontal portion produced by Johnson's fold, is used to support the functional member, which in this instance is a sanitary napkin for menstrual purposes.

The prior Cartledge, British patent 494,393 (R. 61a) also shows a drop front supporter and in the following language (R. 62a):

> "Of course, joint 2 need not necessarily be the ends of the band, for, though not preferred, the *angle may be provided by a fold* while the ends may meet anywhere around the body."

describes a construction which is precisely like that of the patent in suit.

Defendant moved for summary judgment under the provisions of Rule 56 of the Federal Rules of Civil Procedure, asserting that the patent in suit was neither valid nor infringed (R. 13a).

"Rule 56
"Summary Judgment
* * * * *

"(b) For Defending Party. A party against whom a claim, counterclaim, or cross-claim is asserted or a declaratory judgment is sought may, at any time, move with or without supporting affidavits for a summary judgment in his favor as to all or any part thereof.

"(c) * * * The judgment sought shall be rendered forthwith if the pleadings, depositions, and admissions on file, together with the affidavits, if any, show that *there is no genuine issue as to any material fact* and that the *moving party is entitled to a judgment as a matter of law.*"

The District Court granted the motion on the ground that the patent in suit was invalid, and being invalid, was not infringed. The Court of Appeals affirmed.

Argument

Because this is the only suit in which petitioner's patent has been adjudicated, there is no conflict of decisions regarding it.

Nor is there any special or important reason for granting this petition, as required by Rule 38 of this court.

The only question involved is whether there was a *genuine* issue as to any material fact. Both the District Court and the Court of Appeals for the Third Circuit held there was not.

There may be, and frequently are, questions of fact to be decided when a court determines a question of patent validity. But it does not follow that validity must always be decided as a question of fact.

The Patent Office history of the patent in suit and the prior patents upon which the defendant relied, were all before the court. There was, and could be, no dispute as to what these documents said. They spoke for themselves and no amount of testimony by expert witnesses, or others, including plaintiff, could vary the language of these documents in the slightest degree.

Where no extrinsic evidence is necessary for a complete understanding of the documents involved, *the court should regard validity as a matter of law.* The lower court clearly understood this rule and cited in support thereof the case of *U. S.* v. *Esnault-Pelterie,* 303 U. S. 26. This court there said (p. 30):

> "We are not unmindful of the rule that where, with all the evidence before the court, it appears that no substantial dispute of fact is presented, and that the case may be determined by a mere comparison of structures and extrinsic evidence is not needed for purposes of explanation, or evaluation of prior art, or to resolve questions of the application of descriptions to subject-matter, the questions of invention and infringement may be determined as questions of law. *Heald* v. *Rice,* 104 U. S. 737, 749; *Singer Mfg. Co.* v. *Cramer,* 192 U. S. 265, 275; *Sanitary Refrigerator Co.* v. *Winters,* 280 U. S. 30, 36."

In *Singer Co.* v. *Cramer,* 192 U. S. 265, 275, this court dealt with the issue of infringement (but the rule is equally applicable to validity). It said:

> "As in each of the patents in question it is apparent from the face of the instrument that extrinsic evidence is not needed to explain terms of art therein, or to apply the descriptions to the subject matter, and as we are able from mere comparison to comprehend what are the inventions described in each patent and

from such comparison to determine whether or not the Diehl device is an infringement upon that of Cramer, the question of infringement or no infringement is one of law and susceptible of determination on this writ of error."

The rule is also clearly stated in *Ryan Distributing Corp.* v. *Caley,* 3 Cir., 147 F. 2d 138 (cert. denied 325 U. S. 859). Plaintiff brought a declaratory judgment suit to have a patent declared invalid or not infringed; defendant counterclaimed for infringement. The lower court set aside the jury's verdict for defendant and entered judgment for plaintiff. Defendant appealed. In affirming, the court said (pp. 140; 141; 142):

> "The issue of invention is ordinarily one for the trier of fact. (Citing cases.) But in any question of fact, 'a verdict will normally be directed where both the facts and the inferences to be drawn therefrom, as supported by the overwhelming weight of the evidence, point so strongly in favor of one party or the other that the court feels reasonable men could not possibly come to a contrary conclusion.' 3 Moore's Federal Practice, p. 3104. * * * Whatever the extent of the power in patent cases may be it is certainly as wide upon the question of invention as upon any other question, ordinarily treated as one of fact, but called a 'question of law' when its decision becomes the responsibility of the judge. (Citing cases). That responsibility was properly assumed by the trial judge in this case."

The four cases upon which plaintiff relies and quotes in its brief, are readily distinguishable, and are not pertinent.

Thus, in *Bowers* v. *E. J. Rose Mfg. Co.,* 9 Cir., 149 F. 2d 612, 616, the court said:

> "Here the affidavits of fact are so in opposition that there is a 'genuine issue as to a material fact,' and

> hence no warrant for a summary judgment within Rule 56 (b) and (c) of the Federal Rules of Civil Procedure."

In *Weil* v. *N. J. Richman Co.*, S. D. N. Y., 34 F. Supp. 401, 402, the court said:

> "I believe there is a very grave question as to whether or not there is an infringement."

In *Engineering Specialties Co.* v. *Burgess Battery Co.*, S. D. N. Y., 40 F. Supp. 1014, the court referred to "the conflicting affidavits of the experts" on the motion for summary judgment.

In *Baker* v. *First National Stores,* D. C. Mass., 64 F. Supp. 979, the patent in suit (unlike the simple device of the present case) was for a machine for dispensing wax paper packages and defendant was moving for summary judgment on the ground of "misuse" of the patent. The Court said there was no "misuse" and then went on to refer to validity, making the statements quoted in petitioner's brief which are merely *dicta.*

CONCLUSION

The Courts below correctly decided there was no genuine issue of fact and that the patent in suit was invalid. No reason appears for the grant of a writ of certiorari.

The petition should be denied.

Respectfully submitted,

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May, 1950